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| APPLICATION NO. | FILING DATE | FIRST NAMED INVENTOR | ATTORNEY DOCKET NO. | CONFIRMATION NO. |
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| 10/840,188 | 05/05/2004 | Mark L. Mathis | 10057-719.201 | 7264 |

66854 7590 07/09/2010
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| EXAMINER |
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NGUYEN, TUAN VAN

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| ART UNIT | PAPER NUMBER |
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3731

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07/09/2010

PAPER

Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

| | | | |
|------------------------------|--------------------------------------|--------------------------------------|--|
| Office Action Summary | Application No. 10/840,188 | Applicant(s) MATHIS ET AL. | |
| | Examiner TUAN V. NGUYEN | Art Unit 3731 | |

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 23 March 2010.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-17 and 19-30 is/are pending in the application.
- 4a) Of the above claim(s) 1-16 and 21-27 is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 17, 19, 20 and 28-30 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 05 May 2004 is/are: a) ☒ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
- ☐ Certified copies of the priority documents have been received.
 - ☐ Certified copies of the priority documents have been received in Application No. _____.
 - ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|--|---|
| 1) <input type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413) |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | Paper No(s)/Mail Date. _____ |
| 3) <input checked="" type="checkbox"/> Information Disclosure Statement(s) (PTO/SB/08) | 5) <input type="checkbox"/> Notice of Informal Patent Application |
| Paper No(s)/Mail Date <u>3/23/10, 2/01/10, 7/10/09, 10/23/09</u> | 6) <input type="checkbox"/> Other: _____ |

DETAILED ACTION

1. In previous Office Action, claims 1-17 and 19-28 were pending, claims 17 and 19-20 were examined and rejected, claims 1-16 and 21-27 have been withdrawn from consideration as being drawn to nonelected inventions and claim 18 has been cancelled.
2. This Office Action is in response to the amendment filed on 3/23/10.

Response to Amendment

3. Applicant's arguments filed on 3/23/2010, claims 17 and 28 have been amended and claims 29 and 30 are new. Accordingly, claims 1-17 and 19-28 are pending and claims 17, 19, 20 and 28-30 are presented for examination.
4. The amendment to claims 17 and 28 have overcome the rejections under 35 USC § 102(e) as being anticipated by Solem et al. and the nonstatutory obviousness-type double patenting as being unpatentable over claim 15 of U.S. Patent No. 6,908,478 to Alferness et al. Therefore, the rejections have been withdrawn.

Double Patenting

5. The nonstatutory double patenting rejection is based on a judicially created doctrine grounded in public policy (a policy reflected in the statute) so as to prevent the unjustified or improper timewise extension of the "right to exclude" granted by a patent and to prevent possible harassment by multiple assignees. A

nonstatutory obviousness-type double patenting rejection is appropriate where the conflicting claims are not identical, but at least one examined application claim is not patentably distinct from the reference claim(s) because the examined application claim is either anticipated by, or would have been obvious over, the reference claim(s). See, e.g., *In re Berg*, 140 F.3d 1428, 46 USPQ2d 1226 (Fed. Cir. 1998); *In re Goodman*, 11 F.3d 1046, 29 USPQ2d 2010 (Fed. Cir. 1993); *In re Longi*, 759 F.2d 887, 225 USPQ 645 (Fed. Cir. 1985); *In re Van Ornum*, 686 F.2d 937, 214 USPQ 761 (CCPA 1982); *In re Vogel*, 422 F.2d 438, 164 USPQ 619 (CCPA 1970); and *In re Thorington*, 418 F.2d 528, 163 USPQ 644 (CCPA 1969).

A timely filed terminal disclaimer in compliance with 37 CFR 1.321(c) or 1.321(d) may be used to overcome an actual or provisional rejection based on a nonstatutory double patenting ground provided the conflicting application or patent either is shown to be commonly owned with this application, or claims an invention made as a result of activities undertaken within the scope of a joint research agreement.

Effective January 1, 1994, a registered attorney or agent of record may sign a terminal disclaimer. A terminal disclaimer signed by the assignee must fully comply with 37 CFR 3.73(b).

6. Claim 28 is rejected on the ground of nonstatutory obviousness-type double patenting as being unpatentable over claim 7 (encompass claims 6, 5 and 1) of U.S. Patent No. 7,311,729 to Mathis et al. Claim 28 recites a method of modifying target tissue shape comprising: providing a tissue shaping device comprising proximal and distal anchors, a focal deflector; advancing the tissue shaping device to a lumen adjacent the target tissue; expanding the distal anchor to anchor the distal anchor in the lumen; applying a proximally directed force on the distal anchor, wherein applying the proximally directed force on the distal anchor applies

a shaping force from the focal deflector against the lumen wall to modify the shape of the target tissue; and expanding the proximal anchor to anchor the proximal anchor, wherein expanding the proximal anchor occurs while applying the proximally directed force. Claim 7 of U.S. Patent No. 7,311,729 to Mathis et al. recites a method of modifying the shape of tissue adjacent to a lumen, the method comprising: delivering a device into the lumen, the device comprising an anchor and a reshaper extending from the anchor; expanding the anchor into an expanded configuration to place the anchor in secure contact with a lumen wall; locking the anchor in the expanded configuration; and placing the reshaper in contact with the lumen wall to apply force to the lumen wall to modify the shape of tissue adjacent to the lumen wall, wherein the locking step comprises moving a locking element longitudinally; the placing step comprises applying a proximally-directed force to the anchor and the reshaper; the method further comprising expanding a second anchor into an expanded configuration; and locking the second anchor in the expanded configuration. The difference between claim 28 of the application and claim 7 of the patent lies in the fact that the patent claim includes more elements such as the clock and more specific such as the step of locking the second anchor in the expanded configuration, thus, claim 7 is much more specific.

7. Claims 29 and 30 are rejected for the same reason as claim 28.
8. Although the conflicting claims are not identical, they are not patentably distinct from each other.

Allowable Subject Matter

9. Claims 17, 19, 20, and 28-30 would be allowable if a timely filed terminal disclaimer in compliance with 37 CFR 1.321(c) or 1.321(d), to overcome the double patenting rejection set forth in this Office action.

Conclusion

THIS ACTION IS MADE FINAL. Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the mailing date of this final action.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to TUAN V. NGUYEN whose telephone number is (571)272-5962. The examiner can normally be reached on 9:00 AM - 5:00 PM.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, AnhTuan Nguyen can be reached on 571-272-4963. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Art Unit: 3731

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

/T. V. N./
Examiner, Art Unit 3731

/Anhtuan T. Nguyen/
Supervisory Patent Examiner, Art Unit 3731
6/19/10